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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thomas W. Sherwood

Serial No. 76/157,184

Manny D. Pokotilow of Caesar, Rivise, Bernstein, Cohen &
Pokotilow, Ltd. for Thomas W. Sherwood.

Georgia Ann Carty, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Hohein, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark depicted below



for services identified in the application, as amended, as "manufacture of digital video discs to the order and/or specification of others," in Class 40.¹ Applicant has disclaimed the exclusive right to use "DVD" apart from the mark as shown.

The Trademark Examining Attorney has issued final refusals to applicant's mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), citing two previous Principal Register registrations (owned by the same registrant) of the mark depicted below



for "optical disc players; compact discs containing digital information for display of filmed products," in Class 9,² and for "compact discs containing digital information for

¹ Application Serial No. 76/157,184, filed October 31, 2000. The application is based on applicant's alleged bona fide intention to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Registration No. 2,295,726, issued November 30, 1999. Registrant has disclaimed the exclusive right to use "DVD" apart from the mark as shown.

display of filmed products," also in Class 9.³

(Hereinafter, we shall refer to these registered marks in the singular, e.g., as "the registered mark.")

Applicant has appealed the final refusals of registration. Applicant and the Trademark Examining Attorney have filed main appeal briefs, but applicant did not file a reply brief. At applicant's request, an oral hearing was held on August 12, 2003, at which applicant's attorney and the Trademark Examining Attorney presented arguments. After careful consideration of counsel's arguments and the evidence of record, and for the reasons discussed below, we affirm the Trademark Examining Attorney's Section 2(d) refusals to register applicant's mark.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry

³ Registration No. 2,381,677, issued August 29, 2000. Registrant has disclaimed the exclusive right to use "DVD" apart from the mark as shown.

mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first shall determine whether applicant's mark and the cited registered mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by

the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find that applicant's mark is highly similar to the cited registered mark. In view of the generic nature of the term "DVD", the dominant feature in the commercial impression created by the cited registered mark is the distinctive stylization of the mark's lettering and design. The letters "DVD" in the mark are connected to each other, with the central "V" extending to form the top of the "D" on either side of it. The "D"'s in the mark are left open in their upper-left corners, with a space between the top of the left-hand vertical line and the top horizontal line of the letter. The central "V" is elongated at its lower point in a manner which suggests a stylus which is directed to the center of the disc or which perhaps is "playing" the disc. Each of these distinctive, indeed, arbitrary elements of the registered mark's design is replicated almost exactly in applicant's mark.

The slight differences which might be apparent upon side-by-side comparison of the marks (such as the slightly more pronounced ellipsoid shape of the disc in the registered mark, the "reflective" or more shiny representation of the disc in applicant's mark, and the

fact that the tip of the "V" does not extend all the way to contact with the center of the disc in the registered mark) do not suffice to distinguish the marks. As noted above, such a side-by-side comparison is not the proper test for determining confusing similarity. Likewise, we find that applicant's mere addition of the term "Mr." to its mark does not suffice to distinguish the marks. The term is merely a courtesy title which is subordinate to, and would be perceived as referring directly to, the remainder of the mark, i.e., the stylized "DVD" and disc design.

In short, we find that the marks are highly similar in terms of appearance, sound, connotation and overall commercial impression. The presence of the term "Mr." in applicant's mark renders the marks non-identical in appearance, sound and connotation, but the marks nonetheless are more similar than dissimilar when viewed in their entireties and in terms of their overall commercial impressions. This similarity arises not from the presence in each mark of the generic and disclaimed term "DVD" in conjunction with the depiction of a disc (elements which applicant could have utilized and displayed in his mark in any number of ways), but rather from the fact that those elements are displayed in each mark in a very similar highly distinctive manner. The interconnected letters, the

open "D"'s, and the elongated "V" suggesting a stylus pointed at the disc; these arbitrary design features are the essence of the registered mark's commercial impression. Applicant's mark incorporates them all. Purchasers familiar with the registered mark are likely to assume, if they encounter applicant's highly similar mark on related services, that a source or sponsorship connection exists.

We turn next to the issue of the similarity or dissimilarity of applicant's services, i.e., "manufacture of digital video discs to the order and/or specification of others," and registrant's goods, especially those identified as "compact discs containing digital information for display of filmed products." It is not necessary that the respective goods and services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods and services. *See In re Martin's*

Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Applying these principles in the present case, we find that applicant's services are similar and related to registrant's goods. Applicant's services involve the custom manufacture of goods of the type identified in registrant's registration. Purchasers familiar with registrant's mark for digital video discs are likely to assume, upon encountering applicant's digital video disc custom manufacturing services offered under a similar mark, that applicant's services involve or utilize discs manufactured, distributed or approved by registrant or that some other source or sponsorship relationship exists.

Applicant has not argued that its services and registrant's goods are dissimilar or unrelated. Instead, applicant argues that the purchasers of its services are sophisticated and knowledgeable purchasers, i.e., professional photographers and videographers, who are unlikely to be confused as to the source of the services. We are not persuaded. In the absence of any restriction in applicant's identification of services, we must presume that applicant's services will be marketed to all normal

classes of purchasers of such services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Nothing in the record supports a finding that the normal classes of purchasers of applicant's services would not include ordinary consumers, who can use applicant's services to convert their photographs or home video content to a DVD format. Moreover, in view of the similarity of the marks and the relatedness of the respective goods and services, we find that even sophisticated purchasers are likely to be confused as to source or sponsorship in this case. See *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986); *In re Decombe*, 9 USPQ2d 182 (TTAB 1988); and *In re Pellerin Milnor Corporation*, 221 USPQ 558 (TTAB 1983).

Applicant notes that the Office has issued to applicant a registration of the mark depicted below



for "online retail and wholesale store services featuring digital video discs," in Class 35,⁴ and argues that the present refusal is inconsistent with the Office's issuance to applicant of the prior registration. However, the Office's issuance of applicant's prior registration does not mandate or warrant reversal of the Trademark Examining Attorney's refusal of registration in the present case. It is well-settled that the Board is not bound by prior decisions of Trademark Examining Attorneys, and that we must decide each case on its own merits and on the record before us. *See, e.g., In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Cooper*, 117 USPQ 396 (CCPA 1958) ("...the decision of this case in accordance with sound law is not governed by possibly erroneous past decisions by the Patent Office); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991)(§2(d) refusal based on prior conflicting registration affirmed, despite fact that the conflicting registration had not been cited as bar to applicant's previous registration (now expired) of same mark for same goods; Board not bound by decisions of prior

⁴ Registration No. 2,601,893, issued July 30, 2002. The registration includes a disclaimer of the exclusive right to use "DVD" apart from the mark as shown.

Examining Attorneys); *In re BankAmerica Corporation*, 231 USPQ 873, 876 (TTAB 1986)("Section 20 of the Trademark Act, 15 USC §1070, gives the Board the authority and duty to decide an appeal from an adverse final decision of the Examining Attorney. This duty may not and should not be delegated by the adoption of conclusions reached by Examining Attorneys on different records"); and *In re National Retail Hardware Association*, 219 USPQ 851, 854 (TTAB 1983)("As in Cooper, we do not here have sufficient facts before us on which to evaluate whether the previous action of the Examiner which resulted in issuance of the previous registration was or was not erroneous. Nevertheless, as Cooper held, it is sufficient that the facts now before us and the application to them of sound law persuade us that the mark does not meet the requirements for registration set forth in Sections 2(d) and 2(e)(1) of the statute"). For the reasons discussed at length above, we find that a likelihood of confusion exists in this case and that refusal of registration under Section 2(d) therefore is proper, notwithstanding the Office's issuance of applicant's previous registration.

Finally, applicant notes that the owner of the cited registrations (hereinafter "registrant") did not file an opposition to issuance of applicant's prior registration,

and argues that such failure is evidence of an absence of likely confusion in the marketplace. Although we have taken registrant's failure to oppose applicant's prior application into account in our analysis (under the tenth *du Pont* factor; see *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984)), we do not find that it is entitled to significant, much less dispositive, weight. We cannot determine from this record that registrant's lack of opposition to the prior application was due to a business-driven belief on registrant's part that confusion is unlikely, rather than to some other cause. See *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). We note as well that applicant's prior registration is less than five years old and therefore is still vulnerable to challenge by registrant on any ground permitted by Trademark Act Section 14(1), 15 U.S.C. §1065(1), including priority of use and likelihood of confusion. We find that the fact of registrant's failure to oppose applicant's prior mark is outweighed, in our likelihood of confusion analysis, by the evidence pertaining to the other *du Pont* factors, discussed above, which weighs heavily in favor of a finding of likelihood of confusion.

In summary, we find that a likelihood of confusion exists and that registration of applicant's mark therefore

is barred by Section 2(d). Any doubt as to that result must be resolved against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: Each of the Section 2(d) refusals to register is affirmed.